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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Chris Graham

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)

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EXAMINER

OSMAN, RAMY M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/607,898	Applicant(s) GRAHAM ET AL.	
	Examiner RAMY M. OSMAN	Art Unit 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10-12,16-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10-12,16-19,21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/15/08</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on December 19, 2008, where Applicant amended claims 19,21,22. Claims 1,5-8,10-12,16-19,21-26 remain pending.

Response to Arguments

2. Applicant's arguments in light of the amendments filed 12/19/2008 have been fully considered and are persuasive.

3. The previous 103(a) rejection over Dabbish is withdrawn, thus rendering Applicants arguments moot.

4. However, a new grounds of rejection is presented below in view of Grimes et al (US Publication No 20020002674), and was previously cited in the Form 892 in Office Action dated 9/19/08.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1,5-8,10-12,16-19,21-26 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10607627. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are minor variations of handling content that is rights managed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 8,10,12,16,17,19,21,23-25 rejected under 35 U.S.C. 102(e) as being anticipated by DiSanto et al (US Patent No 6,856,686) in view of Grimes et al (US Patent Publication 2002/0002674).**

9. In reference to claim 8, DiSanto teaches a method for an enabled recipient to handle a received rights-managed email with protected content from a sender, the email comprising a

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main information portion having a message that the email is rights management protected and an attachment portion having the protected content, the method comprising:

receiving the email having protected content in the attachment portion thereof, the protected content being encrypted and decryptable according to a decryption key, the decryption key being encrypted according to a public key of a rights management server to result in an encrypted decryption key; (column 12 lines 53-63 & column 13 lines 30-35)

recognizing that the email has the protected content in the attachment portion thereof, discounting the main information portion of the email; and examining the attachment portion of the email comprising the encrypted decryption key and rights data relating to the protected content, the rights data setting forth each entity that has rights with respect to the protected content, and for each such entity a description of such rights; (column 12 lines 39-48, column 13 lines 30-35, column 13 line 62 – column 14 line 29)

DiSanto fails to explicitly teach retrieving the rights data in the attachment portion of the email; forwarding the retrieved rights data to a rights management server, such rights management server for determining that the recipient is an entity listed in the rights data and issuing to the recipient a license corresponding to the protected content to the recipient based on the rights data, such license specifying rights the recipient has with respect to the protected content as determined from the rights data and also including the decrypted decryption key from the rights data; reviewing the issued license to determine that the recipient has a right to render the protected content of the attachment portion of the email; retrieving the decryption key from the license; and rendering the content.

However, Grimes teaches digital rights management of restricted content which in this regard the content would be the “attachment”. Grimes discloses forwarding the retrieved rights data to a rights management server, such rights management server for determining that the recipient is an entity listed in the rights data and issuing to the recipient a license corresponding to the protected content to the recipient based on the rights data, such license specifying rights the recipient has with respect to the protected content as determined from the rights data and also including the decrypted decryption key from the rights data; reviewing the issued license to determine that the recipient has a right to render the protected content of the attachment portion of the email; retrieving the decryption key from the license; and rendering the content (see at least claims 1-3, also paragraphs 50-56). Grimes discloses this for the purpose of managing access rights for securing restricted content over a network. It would have been obvious for DiSanto to employ the digital rights management of Grimes for the purpose of securing the attachment portion of the email.

DiSanto fails to explicitly teach a description of rights. However, Grimes teaches associated “business rules” (see at least bottom or paragraphs 41 & 57).

10. In reference to claim 10, DiSanto teaches the method of claim 8 wherein the protected content in the attachment portion comprises multiple alternative forms of a body of the email, whereby the recipient can select from among the alternative forms when rendering the protected content (column 13 line 62 – column 14 line 29).

11. In reference to claims 12,16, these claims teach a system that correspond to the method claims of claims 8,10. Therefore, claims 12,16 are rejected based upon the same rationale as given for the rejections of claims 8,10.

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12. In reference to claim 17, DiSanto teaches the system of claim 12 wherein the protected content in the attachment portion comprises a body and an attachment list, the attachment list including preface information, at least one attachment to the body, and any metadata relating to each attachment of the body (column 13 line 62 – column 14 line 29).

13. In reference to claims 19,21, these claims teach a method and computer readable medium respectively, that correspond to the system claims of claims 12,17. Therefore, claims 19,21 are rejected based upon the same rationale as given for the rejections of claims 12,17.

Furthermore, neither DiSanto nor Grimes teaches the amended limitation of claim 19 of "wherein if it is determined that the recipient does not have rights to print the protected content of the attachment portion of the email, print functionality is disabled with respect to the protected content. However, this is simply a minor variation of any sort of restriction that may be placed on accessing and using protected content. "Official Notice" is taken that this is old and well known in the art and would be obvious to one of ordinary skill in the art to modify DiSanto by placing print access rights as part of the protections available to protected content.

14. In reference to claims 23,24,25, these are system claims that respectively correspond to claims 12,16,17 above. Therefore, claims 23-25 are rejected based upon the same rationale as given for the rejections of claims 12,16,17.

15. Claims 11,18,22,26 rejected under 35 U.S.C. 103(a) as being unpatentable over DiSanto et al (US Patent No 6,856,686) in view of Grimes et al (US Patent Publication 2002/0002674) in further view of Beck et al (US Patent No 5,903,723).

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16. In reference to claim 11, DiSanto teaches the method of claim 8. DiSanto fails to explicitly teach wherein the protected content in the attachment portion is compressed to reduce an overall size thereof. However, Beck teaches compressing attachments for the purpose of minimizing storage space for transmitting to a recipient (column 6 lines 37-50). It would have been obvious for one of ordinary skill in the art to modify DiSanto wherein the protected content in the attachment portion is compressed to reduce an overall size thereof as per the teachings of Beck for the purpose of minimizing storage space for transmitting to a recipient.

17. In reference to claims 18,22,26, these claims teach a system and computer readable storage medium respectively that correspond to the method claim 8. Therefore, claims 18,22,26 are rejected based upon the same rationale as given for the rejection of claim 11.

Conclusion

18. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

19. Applicant may not introduce any new matter to the claims or to the specification. For any subsequent response that contains new/amended claims, Applicant is required to cite its corresponding support in the specification. **(See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06)**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2457

March 17, 2009